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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,686	02/20/2004	Pierre Blanchard	249181US	3668
22850	7590	02/24/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,686

Applicant(s)

BLANCHARD ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 35-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

1. Newly submitted claims 19-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly presented method of regulating the rheology during the manufacture of the claimed compositions is related to the originally presented rheology regulator and the newly presented method claims as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the rheology regulator can be added to the claimed compositions after manufacturing the compositions; or the inventions of the originally presented compositions and the newly presented method claims are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the rheology regulator can be added to the claimed compositions after manufacturing the compositions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-9, 14-18, and 35-44 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5533678 Strauch et al..

Strauch discloses the instantly claimed calcium carbonates at the abstract. Column 4, lines 57-62 falls within the scope of the instant claims 7-8 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. The burden is on the applicant to provide proof to the contrary in that the PTO has no experimental facilities. The examiner has not used the applicant's own teachings against them as this rejection is based on the above cited patentee. The inherency above is not based on possibilities but the expectation that the BET surface area referenced will necessarily give the instantly claimed oil absorption as is clearly stated above. No evidence to the contrary is presented. The applicant's argument that the patentee "does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed" is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner. This rejection is therefore maintained.

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5. Claims 1, 5-9, 14-18, and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5533678 Strauch et al..

Strauch discloses the instantly claimed calcium carbonates at the abstract. Column 4, lines 57-62 falls within the scope of the instant claims 7-8 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee’s calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed calcium carbonates as those of the patentee because the patentee encompasses the instantly claimed calcium carbonates and they would have been expected to perform as described by the patentee. The burden is on the applicant to provide proof to the contrary in that the PTO has no experimental facilities. The examiner has not used the applicant’s own teachings against them as this rejection is based on the above cited patentee. The inherency above is not based on possibilities but the expectation that the BET surface area referenced will necessarily give the instantly claimed oil absorption as is clearly stated above. No evidence to the contrary is presented. The applicant’s argument that the patentee “does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed” is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner. This rejection is therefore maintained.

6. Claims 1- 9, 15-18, and 35-44 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5896904 Ozaki et al..

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The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. No evidence to the contrary is presented. The applicant’s argument that the patentee “does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed” is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner. No probative evidence is seen that the disclosed nitrogen absorption does not necessarily give the instantly claimed surface areas and oil absorptions. This rejection is therefore maintained.

7. Claims 1-9, 15, and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5896904 Ozaki et al..

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee’s calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9.

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee’s calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly

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claimed calcium carbonates as those of the patentee because the patentee encompasses the instantly claimed calcium carbonates and they would have been expected to perform as described by the patentee. The applicant's argument that the patentee "does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed" is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner. No probative evidence is seen that the disclosed nitrogen absorption does not necessarily give the instantly claimed surface areas and oil absorptions. This rejection is therefore maintained.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

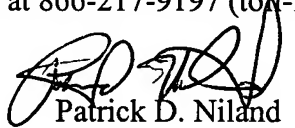
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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